

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent 6,353,038

Allan AHO et al.

Serial Number: 09/446,630

Issued: March 5, 2002

For: NOVEL PLASTIC BASED COMPOSITE AND ITS USE

DECLARATION OF KIM ROERING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Kim ROERING, hereby declare as follows:

1. I am a partner at Turun Patentitoimisto Oy ("Turun"), a Finnish intellectual property law firm. I have practiced intellectual property law since 1998, and am generally familiar with the maintenance fee requirements for U.S. patents.
2. My technical background includes a Masters of Science degree in chemical engineering with a concentration in technical biochemistry, and almost two decades of varied R&D experience in the process and pharmaceutical industries. My curriculum vitae is attached.
3. Vivoxid Oy ("Vivoxid") is a Turun client. My colleague, Ms. Kaisa Suominen, and I worked to obtain patent protection for the inventions Vivoxid entrusted to Turun. From time to time we would meet with Vivoxid to discuss drafting of patent applications for Vivoxid inventions and/or issues relating to prosecution of specific patent applications.

Annuity and maintenance fee payments were generally not discussed during these meetings, as they were the responsibility of Patrafee Oy Ab ("Patrafee"), a commercial annuity payment company. We met with Mr. Jimmy Lucchesi from Fall, 2008 to December, 2009 and subsequently with Dr. Jukka Tuominen.

4. On information and belief, Vivoxid split into two companies, Vivoxid and BonAlive Biomaterials Ltd. ("BonAlive"), in late 2009. Mr. Lucchesi became an employee of BonAlive at this time. Responsibility for Vivoxid's IP matters, including maintenance fee payments, was transferred to Dr. Jukka Tuominen.

Turun's Electronic File System

5. Turun converted to an electronic file system by December 15, 2008. Since then all documents are included in our electronic files. Although some physical ("paper") files remain, they generally only comprise the parts of the file generated before December 15, 2008 and possibly some later documents such as cited references. These paper files are unofficial files, while the electronic file - which contains every document generated or received for that case before or after December 15, 2008 - is Turun's "official" file.

6. Turun maintains a general client electronic file for Vivoxid. A corresponding general client electronic file was created for BonAlive when it was formed and became a Turun client.

7. In addition to the general client file, Turun creates and maintains an individual matter electronic file for each application entrusted to us by that client. For example,

Turun maintains an individual electronic file for U.S. Patent 6,353,038 ("the '038 patent").

8. Turn did not (and does not) maintain a general file for each of Vivoxid's patent families.

The January 2010 Joint Meeting

9. I attended a meeting with Mr. Lucchesi, Dr. Tuominen, Ms. Suominen and Ms. Paivi Salonen, a Turun trademark specialist, on January 19, 2010 ("Joint Meeting") to discuss BonAlive's creation, the resulting changes to Vivoxid and how Vivoxid's intellectual property portfolio was to be divided between the two companies. Exhibit 12 is a memorandum I authored which summarizes the Joint Meeting.

10. The Joint Meeting was held at Turun's office. The initial portion of the Joint Meeting confirmed (1) Turun would represent both Vivoxid and BonAlive in intellectual property matters, (2) Vivoxid's core business would be its FiberLive business line, (3) BonAlive's core business would be the BonAlive product line previously owned by Vivoxid, and (4) Vivoxid's MetAlive business may be sold or licensed. Housekeeping items such as identification of contact personnel, and authorized users of Turun's secure electronic platform (Bextranet®)¹ were also discussed.

¹The Bextranet service is an electronic platform available to Turun's clients but separate from Turun's electronic file system. During the 2009-2010 time period, Bextranet included a secure e-mail service, and was being expanded to comprise an IP management tool, which has since been renamed Greip. On information and belief, Bextranet could not show lapsed cases before 2011, and would only show cases which were about to be abandoned if the user had configured the software to show such cases. Dr. Tuominen did not access the Bextranet system until February 12, 2010, and then, I believe, only for its secure e-mail function.

11. We discussed Vivoxid's trademark portfolio during the second portion of the Joint Meeting. The BonAlive® trademark was to be transferred to BonAlive, while the remaining marks were to be retained by Vivoxid, at least initially. Three other marks were specifically discussed, as well as the possibility of Turun presenting a joint trademark training seminar to both companies.

12. The third portion of the Joint Meeting dealt with Vivoxid's patent portfolio, which at one time comprised 15 patent families, each patent family being directed to a specific invention and comprising pending applications and issued patents. Our discussion focused on the division of each family between Vivoxid and BonAlive based on their respective business activities, and whether to maintain or abandon certain of these patent families. There was no substantive discussion of individual patents or pending applications.

13. It was agreed Vivoxid would continue to own the Sulamuovi patent family, and that Vivoxid would evaluate whether to continue to maintain this patent family.

14. I do not recall any discussion of the individual members of the Sulamuovi patent family. In particular, I do not recall any discussion of U.S. Patent 6,353,038 ("the '038 patent"), which is part of Vivoxid's Sulamuovi patent family, during the Joint Meeting.

15. The Joint Meeting concluded with an agreement that a decision regarding the filing of a continuation of a specific PCT application would be made soon.

16. We used Turun's general client electronic files for Vivoxid and BonAlive for and possibly during the Joint Meeting. I do not recall any individual electronic files for

patents or trademarks were reviewed during the Joint Meeting. However, it is possible one of the participants reviewed an individual electronic file to confirm a detail or fact.

17. On information and belief, Exhibit 12 was placed in Turun's general client files for Vivoxid and BonAlive, and sent to both companies. Copies of Exhibit 12 were not placed in each individual patent and trademark file. In particular, Exhibit 12 was not placed in Turun's individual electronic file for the '038 patent.

18. I do not recall reviewing Turun's individual electronic file for the '038 patent either during the Joint Meeting or afterwards while preparing Exhibit 12.

19. The January 19, 2010 Joint Meeting was the only meeting held to discuss the division of Vivoxid's IP portfolio. No other joint meetings among Vivoxid, BonAlive and Turun took place.

Vivoxid/Turun Meetings

20. As discussed above in paragraph 3, Ms. Suominen and myself held general patent meetings with Vivoxid. The general patent meetings which were held beginning after the mailing of Patrafee's June 9, 2009 confirmation letter (Exhibit 7) until after Turun received the Notice of Patent Expiration (Exhibit 10) in April, 2010 are listed below:

A. July 7, 2009 general patent meeting - Mr. Lucchesi, Ms. Suominen and myself attended this meeting. The Sulamuovi patent family was not on the meeting agenda, and I do not recall any discussion of the Sulamuovi family or the '038 patent.

B. November 11, 2009 general patent meeting - Mr. Lucchesi, Ms. Suominen and myself attended this meeting. The Sulamuovi patent family was not on the meeting agenda, and I do not recall any discussion of the Sulamuovi family or the '038 patent.

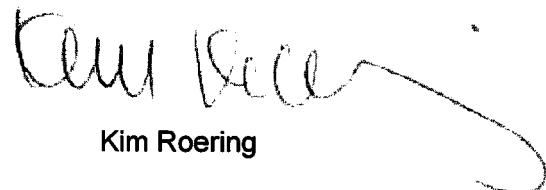
C. June 29, 2010 general patent meeting - Dr. Tuominen, myself and Mr Lehtonen, a Vivoxid researcher attended this meeting. The Sulamuovi patent family was not on the meeting agenda, and I do not recall any discussion of the Sulamuovi family or the '038 patent.

Abandonment of the '038 Patent

21. On information and belief, Turun received a copy of a letter addressed to Vivoxid from Patrafee stating that the '038 patent would be allowed to lapse by non-payment of its annuity in accordance with Vivoxid's instructions (Exhibit 7).
22. I do not recall reviewing Exhibit 7. On information and belief, Exhibit 7 was scanned into Turun's individual electronic file for the '038 patent then reviewed by Ms. Suominen, and the status of the '038 patent was then changed to "abandoned".
23. On information and belief, Turun subsequently received a Notice of Patent Expiration for the '038 patent (Exhibit 10) which was scanned into Turun's individual electronic file for the '038 patent.
24. I do not recall reviewing either Exhibit 10 or the '038 patent's electronic file until March 29, 2012, when Dr. Tuominen requested me to determine whether the '038 patent was still in force.
25. All statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true. These statements are made

with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the '038 patent.

Signed this 5 day of November, 2012.

A handwritten signature in black ink, appearing to read "Kim Roering".

Kim Roering

Enclosure:

[Curriculum Vitae of Kim Roering](#)

CURRICULUM VITAE

1.11.2012

Name Roering, Kim Otto

Date and place of birth 12.7.1953, Helsinki, Finland

Working experience

Patent agent	Turun Patenttitoimisto Oy, Turku	1998–
Quality Assurance Auditor	Orion Pharma R&D, Turku	1993–1998
Laboratory Manager	Orion Pharma R&D, Turku	1992–1993
Project Manager	Orion Pharma R&D, Turku	1985–1992
R&D Engineer	Oy Alko Ab, Koskenkorva	1980–1985
Project Manager	Vesikemia Oy, Helsinki	1979–1980

Education

M.Sc. (Chem. Eng.)	Helsinki University of Technology	1977
Matriculation examination	Helsingin normaalilyseo	1972

Languages

Finnish	Mother tongue
English	Excellent
Swedish	Good
German	Passable

Professional Qualifications

Registered Finnish Patent Agent

Membership in following Professional Organizations

The Finnish Association for Patent Practitioners in the Finnish Industry
Finnish Patent Attorney Association

Special fields of Expertise

Chemistry, Biotechnology, Medicinal technology